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GREENBERG TRAURIG, LLP (CHI) 77 WEST WACKER DRIVE SUITE 3100 CHICAGO, IL 60601-1732				ZIMMERMAN, BRIAN A
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARCUS ESCOBOSA, PATRICK H. HAYES, and JAMES N.  
CONWAY, JR.

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Appeal 2009-010122  
Application 09/615,473  
Technology Center 2600

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Before, JOSEPH F. RUGGIERO, ELENI MANTIS MERCADER, and  
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

WHITEHEAD, JR., *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

### *Introduction*

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 54-62, 64, 66, 68-72, 74, 76 and 80. Appeal Brief 4-5. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.

### *Exemplary Claim*

Exemplary independent claim 54 under appeal reads as follows:

54. A method for selecting a command set for use in a remote control, comprising:  
receiving user input at a computer that functions to specify a type of a consumer electronic device and a brand of the consumer electronic device; using the user input at the computer to select a plurality of command sets that have been identified as being candidates for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device; and  
causing at least a subset of each of the plurality of selected command sets to be downloaded from the computer into the remote control whereby a user may interact with the remote control to determine by experimentation which one of the plurality of command sets is appropriate for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device.

### *Rejections on Appeal*

Claims 54-59, 61 and 70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 6,008,735 issued to Chiloyan. (“Chiloyan”). Appeal Brief 3-6.

Claims 62, 64, 66, 68 and 69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chiloyan and U.S. Patent Number 6,211,870 to Foster (“Foster”). Appeal Brief 7-9.

Claims 60, 71, 72 and 80 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chiloyan and WO 0017738 to Kemink (“Kemink”). Appeal Brief 9-11.

Claims 74, 76, 78 and 79 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chiloyan, Kemink and Foster. Appeal Brief 11.

*Appellant’s Contentions*

1. Chiloyan fails to disclose, teach, or suggest a computer that is capable of downloading to a remote “a plurality of command sets that have been identified as being candidates for commanding operations of the specified type of consumer electronic device.” Appeal Brief 7-8.
2. The express teachings of Kemink negate any need for a user to determine by experimentation which one of the plurality of selected command code sets is appropriate for commanding operations of an appliance. Appeal Brief 9-10.

*Issue on Appeal*

Did the Examiner err in rejecting claims 54-62, 64, 66, 68-72, 74, 76, and 80?

**PRINCIPLE OF LAWS**

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). If the Examiner’s burden

is met, the burden then shifts to the Appellants to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

“Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR Int’l v. Teleflex, Inc.*, 550 U.S. 398, 420 (2007).

“What the prior art teaches and whether it teaches toward or away from the claimed invention … is a determination of fact.” *Para-Ordnance Mfg., Inc. v. SGS Imps. Int’l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995) (citations omitted). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Teaching an alternative or equivalent method, however, does not teach away from the use of a claimed method. *In re Dunn*, 349 F.2d 433, 438 (CCPA 1965).

## ANALYSIS

We have reviewed the Examiner’s rejections in light of the Appellant’s arguments (Appeal Brief and Reply Brief) that the Examiner has erred.

We disagree with the Appellant's conclusion. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) reasons set forth by the Examiner in the Examiner's Answer<sup>1</sup> in response to Appellant's Appeal Brief. We concur with the conclusion reached by the Examiner.

The Examiner made a new grounds of rejection over the Chiloyan reference changing the original rejection of claim 54 and its dependent claims from a §102 to a §103. Answer 3-6.

Appellants address the new grounds of rejection in the Reply Brief and argue that the Examiner employed impermissible hindsight. Reply Brief 2. Appellants further argue that although the Examiner states that there exists some suggestion or motivation to modify Chiloyan, there is not a reference of record that teaches or suggests the specific claim elements that have been acknowledged to be missing from Chiloyan. Reply Brief 3.

It is the Examiner's position that Chiloyan discloses the invention with the exception of specifying the type of download available to the user. Answer 4-5. Chiloyan provides the option of accessing a computer to download additional codes and data from the computer (Column 5, lines 25-35; Figure 1) but does not specify "candidate command sets" as well as having the user interact with the remote control "to determine by experimentation which one of the plurality of command sets is appropriate." Answer 4-5. However, we agree with the Examiner that while Chiloyan does not expressly state how code sets are downloaded from the

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<sup>1</sup> We are referring to the Examiner's Answer mailed January 3, 2007 and the Supplemental Examiner's Answer mailed March 23, 2007.

computer, in view of the discussion or teachings of Chiloyan, downloading codes sets that would be candidates for the controlled appliance would be most efficient and obvious to one of ordinary skill in the art because one skilled in the art would be well aware of the desirability to provide efficiency in the programming mode of a remote control since users would not want to spend hours programming their remote controls. Answer 4-5; Supplemental Answer 3-4.

Appellants contend that the express teachings of Kemink negate any need for a user to determine by experimentation which one of the plurality of selected command code sets is appropriate for commanding operations of an appliance as recited in claim 71. Appeal Brief 9. It is the Examiner's position that Chiloyan teaches that user experimentation (Column 2, lines 34-47) on a group of candidate sets is advantageous in efficiently programming the system and reducing frustration. Further, Kemink (lines 28-31, page 4; lines 3-5, page 6) does not teach away from Chiloyan because there is no disclosure within Kemick that would indicate that the system would not work with a computer. Answer 12. We agree with the Examiner.

## CONCLUSION

The Examiner has not erred in rejecting claims 54-62, 64, 66, 68-72, 74, 76 and 80 as being unpatentable under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

Appeal 2009-010122  
Application 09/615,473

AFFIRMED

gvw